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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,850	11/05/2003	Marcus A. Maxwell	9060.225	7801
7590 02/21/2007 Elizabeth A. Stanek Myers Bigel Sibely & Sajovec, P.A. Post Office Box 37428 Raleigh, NC 27627			EXAMINER HARRIER, JASON D	
			ART UNIT	PAPER NUMBER
			3628	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/21/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/701,850	MAXWELL, MARCUS A.	
	Examiner	Art Unit	
	Jason D. Harrier	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Requirement for Information Under 37 C.F.R. § 1.105

1. Applicant and assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.
2. The information is required to identify publications embodying the disclosed subject matter of a method for determining the business value of an information technology application. The Examiner upon conducting a search for prior art, discovered three published documents titled "LanSafe v. 5 Features and Benefits" (copy attached), "POWERWARE CORPORATION INTRODUCES NEW POWER MANAGEMENT SOFTWARE WITH INDUSTRY-FIRST FEATURES" (copy attached), and "LanSafeV. 5 UPS Power Management Software for Network Shutdown" (copy attached). The "LanSafe v. 5 Features and Benefits" document discloses the LanSafe software with Cost Savings Calculator. The "POWERWARE CORPORATION INTRODUCES NEW POWER MANAGEMENT SOFTWARE WITH INDUSTRY-FIRST FEATURES" discloses a software product called LanSafe v. 5 with Cost Savings Calculator. The "LanSafeV. 5 UPS Power Management Software for Network Shutdown" document discloses a presentation in which the applicant was a presenter and disclosed detailed information related to the Cost Savings Calculator function of the LanSafe v. 5 software. In response to this requirement please provide any known publications, brochures, manuals and press releases that describe the "LanSafe v. 5 Features and Benefits" or LanSafe v. 5 software product, "POWERWARE CORPORATION INTRODUCES NEW POWER

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MANAGEMENT SOFTWARE WITH INDUSTRY-FIRST FEATURES” and the “LanSafeV. 5 UPS Power Management Software for Network Shutdown” presentation.

3. The fee and certification requirement of 37 C.F.R. § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. § 1.105 that are included in the applicant's first complete communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. § 1.105 are subject to the fee and certification requirements of 37 C.F.R. § 1.97.

4. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

5. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item or required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

6. This requirement is subject to the provisions of 37 C.F.R. §§ 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per Claims 1-5, the claims do not recite an pre- or post-computer activity but merely perform a series of steps of selecting, storing, generating and transmitting data related to the status of a backup power supply. A process is statutory if it requires physical acts to be performed outside of the computer independent of and following the steps performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure (*Diamond v. Diehr*, 450 U.S. at 187, 209 USPQ at 8). Further, the claims merely manipulate an abstract idea (selecting, storing, generating and transmitting data) or perform a purely mathematical algorithm without limitation to any practical application. A process which merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might have some inherent usefulness (*Sakar*, 558 F.2d at 1335, 200 USPQ at 139).

Furthermore, in determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a “useful, concrete and tangible result” is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “use, concrete and tangible result”. The test for practical application as applied by the examiner involves the determination of the following factors”

(a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

(b) “Tangible” – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) “Concrete” – Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate

rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

The claims, as currently recited, appear to be directed to nothing more than a series of steps including selecting, storing, generating and transmitting data related to the status of a backup power supply without any useful, concrete and tangible result and are therefore deemed to be non-statutory. While these numbers may be concrete and/or tangible, there does not appear to be any useful result.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 10 and 12-13** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 10 and 12-13 are written in “single means claim” format since they recite only one element to do all the functions recited. The claim is not written in “means-plus-function” language, however, in *Fiers v. Revel*, (CAFC) 25 USPQ2d 1601, 1606 (1/19/1993), the CAFC affirmed a rejection under 35 USC 112 of a claim reciting a single element that did not literally use “means-plus-function” language. Claims 10 and 12-13 are drawn to any “data processor”, regardless of construct, that

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performs the function recited. This parallels the fact situation in *Fiers* wherein “a DNA” and a result was recited. The CAFC stated in *Fiers* at 1606, “Claiming all DNA’s that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived.” See also *Ex parte Maizel*, (BdPatApp&Int) 27 USPQ2d 1662, 1665 and *Ex parte Kung*, (BdPatApp&Int) 17 USPQ2d 1545, 1547 (1/30/1989) wherein the claims at issue were rejected for being analogous to single means claims even though “means” was not literally used. Thus, claims 10 and 12-13 yield a “data processor” that achieves a result without defining what will do so.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fallon et al. (U.S. Patent Pub. No. 2003/032949 A1) (hereinafter Fallon) in view of Eulau et al. (U.S. Patent No. 6,411,910 B1) (hereinafter Eulau).

As per Claims 1, 10, and 14, Fallon discloses a method, calculator and computer program product that estimates a cost savings attributable to use of a backup power system, comprising the following steps implemented in a data processing system: obtaining historical power status information relating to operation of the backup power system. (Figure 10; 0016;

0017; 0081; 0108; 0109). Fallon fails to disclose the computing the estimate of cost savings from the obtained historical power status information. However, Eulau teaches computing the estimate of cost savings from the obtained historical power status information. (Figures 5-19; Col. 2, lines 5-50; Col. 3, line 65 – Col. 4, line 10; Col. 5, line 55 – Col. 6, line 15). Therefore, it would have been obvious to one of ordinary skill in the art to use the historical data obtained from Fallon with the cost savings as taught by Eulau, because informing the user of a backup power supply of the cost savings realized through the use of such a device is an excellent means to justify the purchase and maintenance of a backup power supply and provide the user with additional data concerning the operation of their backup power supply.

As per Claim 2, 8, 12, 15, and 21, Fallon further discloses wherein the received historical power status information comprises at least one of a number of power failures and a duration of the power failures, wherein the power outage cost factor comprises a one-time cost factor for a single power failure and/or a cost per hour without power factor and wherein the user interface comprises a graphical user interface (GUI). (Figure 10).

As per Claim 3, 16, Fallon fails to disclose the method of claim 2 further comprising: obtaining a one-time cost factor for a single power failure; and obtaining a cost per hour without power factor. However, Eulau teaches the collection and generation of various data pertaining to the costs associated with a power loss. (Figures 5-19; Col. 2, lines 5-50; Col. 3, line 65 – Col. 4, line 10; Col. 5, line 55 – Col. 6, line 15) Examiner interprets the data collected in Eulau to include both the cost per hour and single incident cost because the collection of data includes a wide range of values that can be used to accurately compute both of these values. In fact, cost per hour values are explicitly disclosed and the cost per incident value is merely a function of

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the cost per hour value. Further, Examiner interprets the total revenue and profit at risk generated by Eulau to be the same as the potential amount saved by a backup power supply. This is because the backup power supply eliminates power failures and reduces the risk to zero, thus recovering the total revenue and profit that was initially at risk. Therefore, it would have been obvious to one of ordinary skill in the art to use the historical data obtained from Fallon with the cost savings data obtained in Eulau, because informing the user of a backup power supply of the cost savings realized through the use of such a device is an excellent means to justify the purchase and maintenance of a backup power supply and provide the user with additional data concerning the operation of their backup power supply.

As per Claim 4, 9, 13, 17, 22, Fallon shows the collection of data pertaining to power failure incidents and the duration of the power failures. Fallon further computes the total power failures and the total duration of power failures and displays these results to the user through a GUI. (Figure 10). Fallon fails to disclose calculating a per incident savings estimate based on the number of power failures and the one-time cost factor; calculating an hourly savings estimate based on the duration of the power failures and the cost per hour without power factor; and calculating the estimate of cost savings associated with the backup power system based on the calculated per incident savings estimate and the calculated hourly savings estimate. However, Eulau teaches the collection and generation of various data pertaining to the costs associated with a power loss. (Figures 5-19; Col. 2, lines 5-50; Col. 3, line 65 – Col. 4, line 10; Col. 5, line 55 – Col. 6, line 15) Examiner interprets the data collected in Eulau to include both the cost per hour and single incident cost because the collection of data includes a wide range of values that can be used to accurately compute both of these values. Further, Examiner interprets the total revenue

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and profit at risk generated by Eulau to be the same as the potential amount saved by a backup power supply. This is because a backup power supply abolishes power failures and reduces the risk to zero, thus recovering the total revenue and profit that was initially at risk. Therefore, it would have been obvious to one of ordinary skill in the art to use the historical data obtained from Fallon with the cost savings data obtained in Eulau and multiply the values to calculate the total estimated cost savings, because informing the user of a backup power supply of the cost savings realized through the use of such a device is an excellent means to justify the purchase and maintenance of a backup power supply and provide the user with additional data concerning the operation of their backup power supply.

As per Claims 5 and 18, Fallon fails to disclose the method of claim 4 further comprising exporting the per incident savings estimate, the hourly savings estimate and/or the estimate of cost savings to a computer application. However, Eulau discloses the exporting of the estimated data to a computer application. (Figure 1; Figure 19; Col. 2, lines 10-13; Col. 3, line 40 – Col. 4, line 10). Examiner interprets exporting to include the computation of data by a computer or internet server and the sending of that data to another computer application (i.e. web browser).

As per Claim 6, 19, Fallon further discloses the method of claim 4 further comprising displaying the one-time cost factor, the cost per hour factor, the number of power failures, the duration of the power failures, the per incident savings estimate, the hourly savings estimate and the estimate of cost savings on a graphical user interface (GUI). (Figure 10; 0009; 0016; 0017)

As per Claim 7, 20, Fallon discloses a method and computer program product that estimates the cost savings attributable to use of a backup power system, the method comprising the following steps implemented on a data processing system:

- receiving historical power status information from a UPS over a communications link; (Figure 10; 0016; 0017; 0081; 0108; 0109) and
- displaying the estimate of cost savings on the user interface. (Figure 10; 0009; 0016; 0017)

Fallon fails to disclose accepting a power outage cost factor from a user interface and computing an estimate of cost savings based on the historical power status information and the power outage cost factor. However, Eulau teaches the acceptance of a power outage cost factor from a user interface (Figure 13) and computing an estimate of cost savings based on the historical power status information and the power outage cost factor. (Figures 5-19; Col. 2, lines 5-50; Col. 3, line 65 – Col. 4, line 10; Col. 5, line 55 – Col. 6, line 15) Examiner interprets the data collected in Eulau to include both the cost per hour and single incident cost because the collection of data includes a wide range of values that can be used to accurately compute both of these values. Further, Examiner interprets the total revenue and profit at risk generated by Eulau to be the same as the potential amount saved by a backup power supply. This is because a backup power supply abolishes power failures and reduces the risk to zero, thus recovering the total revenue and profit that was initially at risk. Therefore, it would have been obvious to one of ordinary skill in the art to use the historical data obtained from Fallon with the cost savings data obtained in Eulau and multiply the values to calculate the total estimated cost savings, because informing the user of a backup power supply of the cost savings realized through the use of such

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a device is an excellent means to justify the purchase and maintenance of a backup power supply and provide the user with additional data concerning the operation of their backup power supply.

As per Claim 11, Fallon further discloses the calculator of claim 10 wherein the data processor is operatively associated with a graphical user interface (GUI) (Figure 10; 0009; 0016; 0017). Fallon fails to disclose wherein the GUI is configured to receive the historical power status information and transmit the historical power status information to the data processor. However, Eualau teaches wherein the GUI is configured to receive the historical power status information and transmit the historical power status information to the data processor. (Figures 5-19; Col. 2, lines 5-50; Col. 3, line 65 – Col. 4, line 10; Col. 5, line 55 – Col. 6, line 15) Therefore, it would have been obvious to one of ordinary skill in the art to combine the calculator and GUI disclosed in Fallon with the entry of historical data as taught by Eualau because informing the user of a backup power supply of the cost savings realized through the use of such a device is an excellent means to justify the purchase and maintenance of a backup power supply and provide the user with additional data concerning the operation of their backup power supply.

Conclusion

Examiner's Note: Examiner has cited particular columns, line numbers, and paragraphs in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing responses, fully consider each of the

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references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Harrier whose telephone number is (571) 272-5866. The examiner can normally be reached on Monday - Friday 9:00am - 5:30pm EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason D. Harrier
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JDH

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

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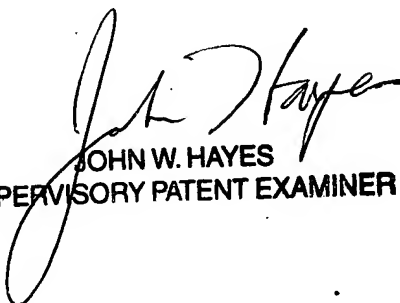
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Or fax to:

(571) 273-5866 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314.



JOHN W. HAYES
SUPERVISORY PATENT EXAMINER